IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:	)Attorney Docket No.: E-906
Raymond G. Mather et al.	)Group Art Unit: 3623
Serial No.: 09/475,364	)Examiner: A. Robinson Boyce
Filed: Dec. 30, 1999	)Date: June 23, 2004
Confirmation No.: 6248	

Title: Method And System For Tracking Disposition Status
Of An Item To Be Delivered Within An Organization

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1 and 3-12 of the above-identified application mailed Jan. 28, 2004. The fee for submitting this Brief is $330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of $330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**. The Notice of Appeal was received by the U.S. Patent and Trademark Office on April 28, 2004. Enclosed with this original are two copies of this brief.

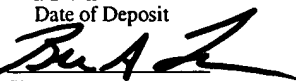06/29/2004 AHONDAF1 00000098 161885 09475364
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I.   Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II.   Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III.   Status of Claims

Claims 1 and 3-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kadaba et al. (EP 0 787 334 B1).

IV.   Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of January 28, 2004. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

V.   Summary of Invention

Appellants' invention relates to a system for tracking the receipt and internal movement resulting in final disposition of items within an organization. As illustrated in Fig. 1, the tracking system 10 comprises a data processing unit 12, a base station 20, a portable data terminal 30 and a connection cradle 50. The portable data terminal 30 is programmed to record the receipt of

items, record and validate the status information regarding the internal movement of the received items, and associate the received items with the recipients, the senders and other related descriptive data elements using barcode scanning, popup, keyboard entry or look-up tables. (Specification, page 10, lines 3-18).

An aspect of the present invention is the ability for each organization to utilize its own preferred format for recording data relating to the receipt and internal delivery of an item by allowing the data collection format for recording tracking information to be created and/or modified by the user of the portable data terminal in accordance with the user's needs. Thus, the portable data terminal 30 is programmed to record information in a certain data collection format. The base station 20 is used to create a new data collection format or modify an existing data collection format according to the use's needs. The base station 20 sends an electronic file via the connection cradle 50 to the portable data terminal 30 to modify the data collection format. (Specification, page 11, lines 21-26).

A data collection format is a different combination of data entry fields including the name of the carrier, the name of the intended recipient (employee), the carrier barcode, the name of the sender, the PO number of Mail Stop number of the internal delivery address, and reference notes. (Specification, page 13, line 27, to page 14, line 3). Fig. 3B, reproduced below, illustrates the format contents of different Receiving data collection formats.

RCV2	RCV1	RCV3	RCVPO	RCVQCK
CARRIER	CARRIER	CARRIER	CARRIER BARCODE	CARRIER
EMPLOYEE NAME	SENDER NAME	CARRIER BARCODE	CARRIER	CARRIER BARCODE
CARRIER BARCODE	EMPLOYEE NAME	EMPLOYEE NAME	SENDER NAME	
	CARRIER BARCODE		PO NUMBER	
			EMPLOYEE NAME	
			REF. NOTES	

FIG. 3B

The user can select one of the receiving data collection formats for recording receipt of an item. However, if the user wants to modify the existing collection formats or create one or more new collection formats, he or she can do so on the base station 20. The modified or newly

crated data collection formats can then be transferred from the base station 20 to the portable data terminal 20 via the connection cradle 50. (Specification, page 14, lines 3-10).

Fig. 11B, reproduced below, illustrates the format contents of different Delivery data collection formats. As shown, each data collection format is a different combination of data entry fields including the name of the carrier, the name of the intended recipient (employee), the carrier barcode, the name of the sender, and the person who actually signs for the delivered item. The user can select one of the delivery collection formats for recording the delivery of an item.

COMBO	DVLDEM	DVL2	DLVQCK	DVL1
CARRIER BARCODE	CARRIER BARCODE	PACKAGE ID	TRACKING NUMBER	EMPLOYEE NAME
CARRIER	EMPLOYEE NAME	DELIVERED TO:	DELIVERED TO:	CARRIER BARCODE
EMPLOYEE NAME	SENDER NAME			DELIVERED TO:
PO NUMBER				

FIG. 11B

If the user wants to create a new data collection format or modify an existing one, the user uses the base station 20. As illustrated in Fig. 16, a Configuration Utility window 300 is displayed to the user after the creation/modifying program has been started. The Configuration Utility window 300 includes a Format option 302 that can be selected to create or modify the Receiving, Delivery or Combination data collection formats as shown in Figs. 3B and 11B. The data collection formats as created and modified in the base station 20 provide configuration information that the portable data terminal 30 uses to control prompts, prompt sequence and field attributes. (Specification, page 21, lines 4-17).

Thus, Appellants' invention provides a portable data terminal that can be used to record data for the receipt of items and the status information related to the internal delivery or other final disposition of the received items. The data collection formats are used for data collection and can be created and/or modified by the user according to the user's needs. The creation and/or modification of the data collection formats are carried out in a base station. The base

station is capable of communicating with the portable data terminal in order to modify the data collection formats.

Additional features of the invention are discussed below in the Argument section of this Brief.

VI.   Issues

A.   Whether the subject matter defined in claims 1 and 3-12 would have been obvious over Kadaba et al.

VII.   Grouping of Claims

Claims 1 and 3-12 are grouped in the following groups:

Group I - Claims 1 and 3-12.

In Group I, all claims stand or fall together.

VIII.   Argument

As Appellants discuss in detail below, the final rejection of claims 1 and 3-12 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A.   The subject matter defined by claims 1 and 3-12 would not have been obvious over Kadaba et al.

Claim 1 is directed to a system for tracking receipt and internal movement of items within an organization. Specifically, claim 1 recites:

> A system for tracking receipt and internal movement resulting in a delivery or other final disposition status of items such as packages within an organization, wherein each item is sent by a sender and received from a carrier to be delivered to a recipient, said system comprising:
>
> a) a portable data terminal programmed to:
>
> (i)   record information regarding the receipt of the item, and
>
> (ii)   record information regarding the internal movement of the item wherein the receipt information and the internal movement information are recorded with a data collection format;
>
> b) a base station capable of communicating with the portable data terminal for uploading electronic files thereto in order to modify the data collection format; and
> wherein the system is configurable so as to allow a user to create one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal.

As noted above, an aspect of the present invention, set forth in independent claim 1, is directed to a base station capable of communicating with the portable data terminal for uploading electronic files thereto to modify the data collection format, where the system is configurable so as to allow a user to create one or more data collection formats at the base station, transmit the data collection formats to the portable data terminal and collect the desired data included in the data collection formats at the portable data terminal. As defined above, a data collection format is a different combination of data entry fields including the name of the carrier, the name of the intended recipient (employee), the carrier barcode, the name of the sender, the PO number of Mail Stop number of the internal delivery address, and reference notes. (Specification, page 13, line 27, to page 14, line 3). Note that the data collection format is in no way related to the manner in which the data is collected, i.e., whether the data is in bar code format and scanned,

entered through a keyboard, etc., but instead relates solely to the different fields of data that can be collected. The present invention therefore provides the ability for each organization to utilize its own preferred format for recording data relating to the receipt and internal delivery of an item by allowing the data collection format for recording tracking information to be created and/or modified by the user of the portable data terminal in accordance with the user's needs. Thus, for example, one organization might desire to collect only the carrier name, employee name, and carrier barcode for the item (illustrated in Fig. 3B above as Receiving data collection format RCV2), while another organization might desire to collect the same information and additionally the sender's name (illustrated in Fig. 3B above as Receiving data collection format RCV1).

Kadaba et al., in contrast, is directed to a parcel tracking system in which the data collection format is fixed and cannot be modified by a user to suit the user's needs. A portable data entry and data processing device includes a processor configured to associate and store in a storage device data related to a particular parcel including symbol information read by the reader, signature information acquired by the screen and keyed information acquired by the screen. (Col. 3, lines 25-30). There is no disclosure, teaching or suggestion in Kadaba et al. of a base station capable of communicating with the portable data terminal for uploading electronic files thereto in order to modify the data collection format; and wherein the system is configurable so as to allow a user to create one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal as is recited in claim 1.

The Final Rejection contends that Col. 10, lines 49-57, of Kadaba et al. discloses a configurable system so as to allow a user to create one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal as is recited in claim 1. Appellants respectfully disagree.

Col. 10, line 45, to Col. 11, line 3, of Kadaba et al. is reproduced below.

> The PDA processor 17 may also carry out a series of utility routines, as shown in Fig. 8. At the main menu, as shown in Fig. 8A, the user may tap the "Utilities" button to view a "Utilities Menu" screen as shown in Fig. 8B. The user may then select between "Management Reports," "Site

Configuration," "Call Management," and DB Maintenance." Fig. 8C shows the "Management Reports" screen, from which the user can cause the processor to generate a variety of reports summarizing delivery activity tracked using the PDA 12. Fig. 8D shows the "Configuration" screen from which the user may adjust address and telephone information for the mailroom location, and alter the configuration of interfaces with the associated devices such as the wand 25, the modem 22, and the printer 48. Fig. 8E shown the "Database Maintenance" screen which allows the user to purge or repair the tracking information in the memory 18.

Thus, as described in the above passage, in Kadaba et al. the PDA processor 17 allows the user to adjust the address and telephone information for the mailroom location, and alter the configuration of interfaces with the devices that can be coupled to the PDA. This is clearly not the same or even related to creating one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal as is recited in claim 1 for at least the following reasons.

Note first that all of the processing described in the above passage is performed by the processor 17 in the PDA 12. There is no disclosure, teaching or suggestion in Kadaba et al. of a base station that is used to create one or more data collection formats. The Final Rejection contends that the PC 40 represents a base station. PC 40 is equipped with an infrared port 42 compatible with the infrared port 23 of the PDA 12. The principal use of the infrared link is to upload tracking information acquired by the PDA into the PC 40. The PC 40 can then be used as a station to search for or print parcel delivery status information. (Col. 6, lines 12-20). While Kadaba et al. also notes that information can be downloaded from the PC 40 to the PDA 12, there is no disclosure, teaching or suggestion of creating one or more data collection formats at the base station, transmitting the one or more data collection formats to the portable data terminal and collecting data in one of the data collection formats at the portable data terminal as is recited in claim 1.

Furthermore, note that the "Site Configuration" utility in Kadaba et al. is not related to the creation of data collection formats, but instead to the ability to configure an interface between the PDA and a peripheral device. These are not the same. The Final Rejection, on page 4, states,

"It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the data collection formats to be configurable for a portable data terminal with the motivation of having the ability to collect information from a wide variety of information sources." As noted above, however, the data collection format of the Appellants' invention is in no way related to the source from, or the manner in, which the data is collected, i.e., whether the data is in bar code format and scanned by a wand, entered through a keyboard, etc., but instead relates solely to the different fields of data that can be collected. The "Site Configuration" in Kadaba et al. allows the user to adjust the peripherals with which the PDA 12 will communicate, but in no way allows the user to create a new data collection format.

There is no disclosure, teaching or suggestion in Kadaba et al. of a base station capable of communicating with the portable data terminal for uploading electronic files thereto in order to modify the data collection format; and wherein the system is configurable so as to allow a user to create one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal as is recited in claim 1. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from this reference. The rejection uses impermissible hindsight to reconstruct the present invention from this reference. See Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support obviousness determination). The fact that the present invention was made by the Appellants does not make the present invention obvious, that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching or motivation in the prior art to do so). No such suggestion, teaching or motivation has been provided by the Final Rejection.

For at least the above reasons, Appellants respectfully submit that the final rejection as to claim 1 is in error and should be reversed. Claims 3-12 are dependent upon claim 1, and therefore include all of the limitations of claim 1. For the same reasons the final rejection as to

claim 1 is in error, Appellants respectfully submit that the rejection of claims 3-12 is similarly in error and should be reversed.

IX.   Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1 and 3-12 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

Brian A. Lemm
Reg. No. 43,748
Attorney for the Appellants
Telephone (203) 924-3836

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, Connecticut 06484-8000

Attachment - Appendix A (3 pages)

APPENDIX A

1.   A system for tracking receipt and internal movement resulting in a delivery or other final disposition status of items such as packages within an organization, wherein each item is sent by a sender and received from a carrier to be delivered to a recipient, said system comprising:

a)   a portable data terminal programmed to:

(i)   record information regarding the receipt of the item, and

(ii)   record information regarding the internal movement of the item wherein the receipt information and the internal movement information are recorded with a data collection format;

b)   a base station capable of communicating with the portable data terminal for uploading electronic files thereto in order to modify the data collection format; and

wherein the system is configurable so as to allow a user to create one or more data collection formats at the base station, transmit the one or more data collection formats to the portable data terminal and to collect data in one of the data collection formats at the portable data terminal.

3.   The system of claim 1, further comprising a data processing unit capable of communicating with the portable data terminal, wherein the data processing unit is programmed to

(a)   maintain a database of records relating to the received items, each of said records identifying an internal delivery address and internal movement status for a corresponding one of said received items;

(b)   maintain a database of recipient names; and

(c)   generate a manifest of selected ones of said received items.

4.   The system of claim 3, wherein the data processing unit is further programmed to maintain a database of sender names, and carrier names related to said received items.

5.   The system of claim 3, wherein the data processing unit is further programmed to provide status information related to said received items through searches, displays, lists, reports and other query and reporting elements.

6.   The system of claim 1, wherein the portable data terminal is further programmed to associate the receipt of items with the recipients, the senders and the carriers.

7.   The system of claim 1, wherein the portable data terminal comprises:

(a)   a display device to display information regarding the receipt and the internal movement of items;

(b)   an inputting device to input information regarding the receipt and the internal movement of items; and

(c)   a communication device to communicate with the base station.

8.   The system of claim 7, wherein the received items contain a barcode to identify the items and the inputting device includes a barcode reader to read the barcode.

9.   The system of claim 7, wherein the information displayed on the display device includes a popup list having entry items in order for a user to enter into the

portable data terminal information regarding the receipt and the internal movement of an item by selecting the entry item from the popup list.

10.   The system of claim 7, wherein the display device displays a plurality of entry fields to allow a user to enter into the portable data terminal information regarding the receipt and the internal movement of an item through the entry fields.

11.   The system of claim 1, further comprising a communication medium so as to allow the portable data terminal to communicate with the base station via the communication medium.

12.   The system of claim 3, further comprising a connection cradle so as to allow the portable data terminal to communicate with the data processing unit via the connection cradle.